

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

Under point 1 on page 2 of the Office Action, the Examiner gives Applicants the option of responding to the new ground of rejection by way of reply or appeal. Applicants elect to reply, hoping that the arguments below will render an appeal unnecessary.

Claims 1, 2, 4-6, 9-11, 14-17, 19 and 20 were rejected under 35 USC § 103(a) as being unpatentable over Schmidt et al. ("Schmidt"), US 5,910,522 in view of Koeble et al. ("Koeble"), US 4,217,434, and Prucker et al. ("Prucker"), Macromolecules, 31: 602-613 (1998). In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

At the outset, Applicants acknowledge with appreciation that the Examiner now agrees that Schmidt does not teach pressure-sensitive adhesives in addition to filler particles comprising a coating of a polyacrylate chemically bonded to a free radical initiator, which initiator is, in turn, chemically bonded to silicate and/or silica gel.

The Examiner now turns to Koeble to show that "the adhesive composition of [Schmidt] is *intrinsically capable* of functioning as a pressure sensitive adhesive when formulated as a composition comprising solvent, transparent polyacrylates and the silica filler, in well known proportions used to prepare pressure sensitive adhesives." When all that is done, who can say whether Schmidt's adhesives have that capacity or not. Still missing is: Why persons skilled in the art would have gone to such trouble?

Certainly, no reason that can be gleaned from Schmidt, as Schmidt is concerned with *liquid contact adhesives* for bonding optical and other parts, *not* pressure-sensitive adhesives.

Schmidt teaches, for example, at column 7, lines 13-24:

“The finished composite adhesive is applied onto the substrate(s) to be connected or said substrate(s) is (are) dipped into said adhesive. If the adhesive does not contain any crosslinkable (polymerizable groups), its curing can be effected by usual drying at temperatures of preferably below 150°C.

“If the composite contains a crosslinkable compound, following the application of the adhesive onto the substrate(s) to be connected, said compound is crosslinked and cured thermally and/or by irradiation (e.g., by means of an UV lamp or laser), depending on the type of crosslinking initiator employed.”

Thus, Schmidt’s mode of operating is to apply the liquid adhesive directly to the substrates to be connected, *then cure* the adhesive as the way of effecting the bond. Proceeding in the manner the Examiner proposes would completely change Schmidt’s mode of operation and is presumptively improper.

In this regard, Applicants refer the Examiner to *MPEP* § 2143.01(V), entitled “**The Proposed Modification Cannot Render the Prior Art Unsatisfactory for It’s Intended Purpose**”; and to *MPEP* § 2143.01(VI), entitled “**The Proposed Modification Cannot Change the Principle of Operation of a Reference.**” Applicants respectfully submit that the Examiner’s proposal somehow to modify Schmidt to a pressure-sensitive adhesive, to the extent the Examiner theorizes that a person having ordinary skill in the art would have been motivated

to do so, violates both of these basic principles of patent law and, therefore, as noted above, is presumptively improper.

In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984), cited and discussed therein, was a case where the Patent Office quite literally tried ***to turn the prior art on its head***. The involved claims related to a blood filter assembly device that required that both blood inlets and outlets be located at the ***bottom*** of the device, and a gas vent be located at the top of the assembly. Such construction was essential for the device to operate as envisioned by the inventors. The cited prior art taught a liquid strainer for removing dirt and water from gasoline, wherein the inlet and outlet were at the ***top*** of the device, and a stopcock was located at the bottom of the device. The prior art reference taught the dirt and water removal was assisted by gravity, thereby fixing the inlet and outlet at the top. Superficially, the prior art device appeared similarly constructed to the claimed device, albeit turned upside down. On appeal, the Board concluded that the claims were *prima facie* obvious over the prior art, reasoning that it would have been obvious to turn the prior art device upside down, as no patentable distinction was created by the viewing the prior art device from one direction as opposed to another.

The Federal Circuit disagreed, holding:

“The mere fact that the prior art could be so modified would not have made the modifications obvious unless the prior art suggested the desirability of the modification.

“Indeed, if the [prior art] apparatus were turned upside down, ***it would be rendered inoperable for its intended purpose.*** * * * In effect, [the prior art reference] teaches away from the board’s proposed modification (emphasis added).”

See, Gordon, 221 USPQ at 1127.

Here too, the Examiner seeks to turn the Schmidt reference on its head, converting a liquid contact adhesive, expressly intended for Schmidt's purpose, into a pressure-sensitive adhesive that is not. While the Examiner has theorized how it might be done, the Examiner has not given any reason why it might be done. And, even if there were some reason to do it, the quotes above make clear that obviousness cannot be based on a theory that proposes to change the basic principle of operation of the reference.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 3 and 12 were rejected under 35 USC § 103(a) as being unpatentable over Schmidt in view of Prucker as evidenced by Knovel (Knovel critical tables – Publication 2003). In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well.

At the outset, Applicants point out that Koeble was not included in this rejection. Whether this was intended or not is unclear. Even with Koeble, Applicants respectfully submit that this rejection is improper for exactly the same reasons outlined above. Nothing in Knovel overcomes the above-noted defects even in the combination of Schmidt, Koeble and Prucker. Even if the Examiner intended not to rely on Koeble here, the combination of Schmidt, Prucker and Knovel more clearly fails to make out a *prima facie* case of the obviousness of the rejected claims. Knovel is relied on to teach the density of inorganic silicates, but does not bridge any of

the above-noted defects in the combination of Schmidt, Koeble and Prucker. Consequently, the combination of Schmidt, Prucker and Knovel, with or without Koeble, cannot make out a *prima facie* case of the obviousness of the rejected claims.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well. An early notice that this rejection also has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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